

REMARKS

The present application includes pending claims 1-28, all of which have been rejected. Claims 1-2, 4-7, 9-11, 13-14, 16-18, 20-22, and 24-28 stand rejected under 35 U.S.C. 103(a) as being unpatentable United States Patent No. 6,114,623 (“Bonilla”) in view of United States Patent No. 5,007,857 (“Wright”). Claims 3, 8, 12, 15, 19, and 23 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Bonilla in view of Wright and United States Patent No. 6,417,446 (“Whitehead”). The Applicants respectfully traverse these rejections for at least the reasons previously discussed during prosecution and the following:

The Applicants note that a goal of patent examination is to provide a prompt and complete examination of a patent application.

It is essential that patent applicants obtain a prompt yet complete examination of their applications. **Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the *initial review* of the application**, even if one or more claims are found to be deficient with respect to some statutory requirement. **Thus, USPTO personnel *should state all reasons and bases for rejecting claims in the first Office action.*** Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, USPTO personnel should indicate how rejections may be overcome and how problems may be resolved. A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.

Manual of Patent Examining Procedure (MPEP) § 2106(II) (emphasis added). As such, the Applicants assume, based on the goals of patent examination noted above, that **the present Office Action sets forth “all reasons and bases” for rejecting the claims**, despite the fact that the present application has gone through extensive prosecution and been subjected to evolving rejections.

I. The Proposed Combination Of Bonilla And Wright Does Not Render Claims 1-2, 4-7, 9-11, 13-14, 16-18, 20-22, And 24-28 Unpatentable

The Applicants first turn to the rejection of claims 1-2, 4-7, 9-11, 13-14, 16-18, 20-22, and 24-28 as being unpatentable over Bonilla in view of Wright. Initially, the Applicants note that the Office Action states the the “[c]laims... are rejected... as being in order to increase the resistance of the poke-through to heat exposure, thus increasing the length of the time that the poke-through device can resist exposure to heat.” *See* February 1, 2007 Office Action at page 3. It is unclear, however, as to what this means, considering that none of the independent claims of the present application recite such language. The Applicants request clarification.

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure (MPEP) states the following:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art.

See MPEP § 2142. Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

Id.

A. The Proposed Combination Of Bonilla And Wright Does Not Teach Or Suggest All The Claim Limitations

Independent claims 1, 6, 11, 14, 18, 21, and 26 specify that each simplex power receptacle includes a respective housing, a feature that is neither disclosed nor suggested by Bonilla. Rather, Bonilla discloses a poke though fitting wherein a single housing (receptacle 34) includes four power outlets 18. The power outlets 18 of Bonilla clearly are not “separately formed simplex power receptacles” because they all share a common housing and also share common bus bar elements. *See* Bonilla at Figures 1 and 4. The power outlets of Bonilla clearly are not “separately formed simplex power receptacles” because none of them has its own respective housing. Instead, as noted above, they are all integral components of a single housing (i.e., receptacle 34).

The Office Action asserts that Bonilla discloses “four separately formed simplex power receptacle.” *See* February 1, 2007 Office Action at page 3. However, the Office Action acknowledges that Bonilla “fails to disclose each of said power receptacles having a separate housing.” *See id.*

The Applicants respectfully point out that, contrary to the interpretation of the Office Action, **Bonilla explicitly states that a single receptacle houses all four power receptacles.** In particular, Bonilla states the following:

Receptacle 34 houses **two pairs of electrical outlets 18**. The first **pair of electrical outlets 104** comprise the “A” **pair** of outlets and the second **pair** out electrical outlets 106 comprise the “B” **pair** of outlets. Each **pair** of outlets 104 and 106 are electrically wired together as is known in the art.

Bonilla at column 4, lines 4-9 (emphasis added). Thus, as clearly stated above, Bonilla discloses **pairs of electrical outlets**, i.e., duplexes, but not simplexes, included within a single housing, i.e. the receptacle 34.

Thus, for at least these reasons, Bonilla does not describe, teach or suggest “four **separately formed simplex power receptacles** supported by the insert, **each simplex power receptacle having a respective housing**,” as recited, for example, in claims 1, 6, 11, 14, 21, and 26.

The Office Action cites Wright in an attempt to overcome the deficiencies of Bonilla. However, Wright relates “to an electrical receptacle **for an electrical extension cord or an adaptor plug**.” *See* Wright at column 1, lines 6-8. As shown in Figures 1-2, Wright merely discloses an extension cord/adaptor plug, but not a simplex power receptacle. As shown in Figure 1 of Wright, for example, the receptacle 12 is merely a part of an extension cord 10. The receptacle for an extension cord/adaptor plug of Wright is by no means configured to fit, or be positioned, within a poke-through fitting, such as the poke-through fitting of Bonilla. Instead, it is used with respect to bulky extension cords and adaptors.

Similar to Bonilla, Wright also does not describe, teach, or suggest “four **separately formed simplex power receptacles** supported by the insert, **each simplex power receptacle having a respective housing**,” as recited, for example, in claims 1, 6, 11, 14, 21, and 26. Because these references alone do not describe, teach, or suggest these limitations, the combination of the two references, by definition, also does not teach or suggest these limitations. Thus, for at least these reasons, the Applicants respectfully submit that the proposed combination

of Bonilla and Wright does not render claims 1-2, 4-7, 9-11, 13-14, 16-18, 20-22, and 24-28 unpatentable.

B. Wright Is Inherently Incompatible With Bonilla

Moreover, the extension cord/adaptor plug of Wright is inherently incompatible with the poke-through floor fitting of Bonilla. As noted in Bonilla, “fire-rated poke-through fittings provide a floor receptacle for electrical outlets and/or for telecommunication access. Generally, these poke through fittings are mounted in a core-drilled, three inch diameter hole, which is commonly found in a concrete floor.” Bonilla at column 1, lines 14-18. The poke-through fitting of Bonilla is “**for use in a three-inch diameter** bore and having four electrical outlets and four voice/data jacks while maintaining a low profile.” *See* Bonilla at column 1, lines 6-10.

To maximize the space in the Bonilla poke-through fitting, a single housing is “efficiently formed” to comprise all four power outlets in the space of less than three inches:

Receptacle 34 houses two pairs of electrical outlets 18. ...
Receptacle 34 is efficiently formed to fit within a three inch diameter opening. That is, receptacle 34 has a width in any direction of plane 211 of less than three inches.

See Bonilla at column 4, lines 4-5 and lines 9-12. Thus, Bonilla “optimize[s] the arrangement of elements to produce a compact fitting with a relatively high number of electrical and voice/data connections while maintaining a low profile, which is generally flat and close to the floor.” *See* Bonilla at column 7, lines 49-53. Bonilla discloses a poke-through configuration that is specifically designed to maximize the number of connections within a limited space. Attempting to substitute the **pairs** of electrical outlets 18 of Bonilla with four bulky electrical cords 12 or adaptor plugs of Wright would add size and bulk to the poke-through fitting, thereby making it

incompatible for its stated purpose of “optimizing the arrangement of elements to produce a compact fitting with a relatively high number of... connections while maintaining a low profile, which is generally flat and close to the floor.” Adding just one of the bulky extension cords/adaptor plugs of Wright would destroy the “low profile” of the Bonilla poke through fitting. Thus, the Applicants respectfully submit that the extension cord/adaptor plug of Wright is inherently incompatible with the poke through fitting of Bonilla.

As set forth above, Bonilla teaches specific arrangements of outlets 18 and data/communication jacks 20, arrangements that have already consumed their allotted spaces. Bonilla does not describe, teach, or suggest how four simplex power receptacles each having its own respective housing could be arranged within the limited spaces that Bonilla describes. Moreover, Bonilla teaches away from each power receptacle having its own respective housing, as noted above. In that regard, Bonilla teaches all four power outlets in a single “efficiently formed” housing that is “less than three inches” in diameter. *See* Bonilla at column 4, lines 4-5 and lines 9-12.

The February 1, 2007 Office Action wholly fails to address the size limitations of Bonilla and the resulting unfeasibility of combining the electrical cord/adaptor plug of Wright with the poke through fitting of Bonilla. For at least these reasons, the Applicants respectfully submit that the proposed combination of Bonilla and Wright is improper, and, therefore, does not render the pending claims unpatentable.

C. The Proposed Combination Of Bonilla And Wright Does Not Describe, Teach, Or Suggest Four Communication/Data Jacks Being Arranged In A Longitudinal Row As Specified By Claims 16-17 and 27-28

The Applicants respectfully submit that the proposed combination of Bonilla and Wright does not render claims 16-17 and 27-28 unpatentable for at least the reasons discussed above. Additionally, independent claims 16 and 27 recite, in part, four communication/data jacks being arranged in a longitudinal row, a feature that is neither disclosed nor suggested by the proposed combination of Bonilla and Wright.

The Office Action asserts that Bonilla discloses “four communication/data jacks 20... being arranged in a longitudinal row (see fig. 1).” *See* February 1, 2007 Office Action at page 7. As clearly shown in Bonilla, however, the jacks 20 are by no means in a row, in general, or a longitudinal row, in particular. Instead, the jacks 20 are radially disposed about a center of the fitting. That is, the jacks 20 are arranged in a circular fashion. Neither Bonilla, nor Wright, however, describes, teaches, or suggests four communication/data jacks being arranged in a longitudinal row, as recited in claim 16 and 27. Thus, for this additional reason, the Applicants respectfully submit that the proposed combination of Bonilla and Wright does not render claims 16-17, and 27-28 unpatentable.

D. No Requirement To Describe A “Criticality”

The Office Action asserts that “[i]t is noted that with respect to Simplex Power receptacle, the Applicant does not describe any criticality of said simplex power receptacle.” *See* February 1, 2007 Office Action at pages 13-14. In general, the simplex power receptacles and configurations shown and described in the present application enable a large number of

components within the limited space of a poke-through fitting. Nevertheless, there is no requirement to describe a “criticality” of a claim term, and the Office Action cites no authority in support thereof.

II. The Proposed Combination Of Bonilla, Wright, And Whitehead Does Not Render Claims 3, 8, 12, 15, 19, And 23 Unpatentable

The Applicants now turn to the rejection of claims 3, 8, 12, 15, 19, and 23 as being unpatentable over Bonilla in view of Wright and Whitehead. The Applicants respectfully submit that this proposed combination does not render these claims unpatentable for at least the reasons discussed above.

III. Conclusion

In general, the Office Action makes various statements regarding the pending claims and the cited reference that are now moot in light of the above. Thus, the Applicants will not address such statements at the present time. However, the Applicants expressly reserve the right to challenge such statements in the future should the need arise (e.g., if such statements become relevant by appearing in an Examiner’s Answer to an Appeal Brief).

The Applicants respectfully submit that all of the pending claims of the present application should be in condition for allowance for at least the reasons discussed above and request reconsideration of the claim rejections. If the Examiner has any questions or the Applicant can be of any assistance, the Examiner is invited to contact the undersigned attorney.

Response Under 37 C.F.R. § 1.111
Serial No. 10/715,942

The Commissioner is authorized to charge any necessary fees or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Respectfully submitted,

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